

## REMARKS

Upon entry of the foregoing Amendment, claims 180-217 are pending in the application. Claims 187, 189-190, 205, and 207-208 have been amended. No claims have been cancelled or newly added. Applicants believe that this Amendment does not add new matter. In view of the foregoing Amendment and the following Remarks, allowance of all the pending claims is requested.

### ENTRY OF THE AMENDMENT

Applicants submit that the foregoing Amendment should be entered for at least the reason that the amendments to the claims do not raise new issues that would require further consideration and/or search, nor do the amendments raise the issue of new matter. More particularly, claims 187, 189-190, 205, and 207-208 have been amended to address a minor typographical error (i.e., duplicating the word "the"), and the claim amendments therefore do not raise new issues that would require further consideration and/or search or the issue of new matter. For at least this reason, the foregoing claim amendments should be entered.

Additionally, Applicants further submit that the foregoing Amendment should be entered because the amendments to the claims materially reduce and simplify the issues for appeal, thereby placing the application in better form for appeal. More particularly, the amendments to claims 187, 189-190, 205, and 207-208 merely obviate typographical errors, and therefore eliminate any potential issues that may be associated with interpreting the claims on appeal. For at least this additional reason, the foregoing claim amendments should be entered.

Accordingly, for at least the foregoing reasons, Applicants request that the Examiner enter the foregoing claim amendments and consider the following Remarks.

### UNEXAMINED CLAIMS

At the outset, Applicants note that the Examiner has failed to treat all of currently pending claims 180-217 on the merits. In particular, in Applicants' previous response filed March 10, 2010, various claims were amended and claims 216-217 were newly added.

However, in the Final Office Action, the Examiner omitted claims 216-217 from the pending claims listed in the Office Action summary and did not address claims 216-217 in any respect.

Accordingly, for at least the reason that the Examiner has failed to examine all of the claims that are currently pending in the application, the Examiner has improperly made the Office Action final. Applicants therefore request that the Examiner withdraw the Final Office Action and treat all of currently pending claims 180-217 on the merits.

**REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH**

The Examiner has rejected claim 189 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.<sup>1</sup> In particular, the Examiner alleges that Applicants' disclosure lacks support for the feature "wherein the data received from the vendor-controlled postage-issuing computer system further verifies consistency between the certificate serial number contained in the postage indicium and a digital signature derived from the tracking identifier further contained in the postage indicium." Applicants traverse this rejection for at least the reason that Applicants' disclosure supports the foregoing feature that allegedly lacks written description.

More particularly, Applicants' disclosure includes various passages that describe a "self-validating unique postage indicium" containing, among other things, a certificate serial number and a digital signature (e.g., page 36, line 11 – page 38, line 12). In addition, various passages in Applicants' disclosure further describe "deriving a digital signature from the unique tracking [identifier]" contained in the unique postage indicium, wherein "the digital signature can be derived from any combination of the items [contained in the unique postage indicium], provided that the unique tracking number is included in the digital signing process" (e.g., page 17, lines 3-7 and page 38, lines 10-12). As such, Applicants' disclosure clearly includes various passages that support the feature that recites a "certificate serial number contained in the

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<sup>1</sup> Applicants note that ¶ 5 in the Office Action indicates that this rejection applies to claim 89. However, because claim 89 was previously cancelled, whereas claim 189 includes the language that the Examiner refers to as allegedly lacking support in Applicants' disclosure, Applicants assume that the Examiner made a typographical error and actually intended this rejection to apply to currently pending claim 189.

postage indicium and a digital signature derived from the tracking identifier further contained in the postage indicium.”

Furthermore, Applicants’ disclosure includes various passages describing techniques that reference data received from a vendor-controlled postage-issuing computer system to verify or otherwise validate the unique postage indicium. For example, various passages in Applicants’ disclosure further describe a postal verifier obtaining information associated with a postage indicium carried on an inspected mail piece “from the centralized postage-issuing computer system 305/306/307,” which “is owned and operated by a postal vendor” (e.g., page 30, lines 10-21 and page 55, lines 4-10). As such, the postal verifier then obtains “the public key corresponding to the Certificate Serial Number . . . within the postage indicium” and “verifies the digital signature of the postage indicium . . . to determine if [the Certificate Serial Number and the digital signature] are consistent” (page 53, lines 11-19).

Accordingly, for at least the reason that the exemplary passages in Applicants’ disclosure provided above (in addition to various other passages) clearly describe a postal verifier using data received from a vendor-controlled postage-issuing computer system to verify consistency between a certificate serial number contained in a postage indicium and a digital signature derived from a tracking identifier further contained in the postage indicium, claim 89 complies with the written description requirement. The rejection is therefore improper and must be withdrawn for at least this reason.

### **REJECTION UNDER 35 U.S.C. § 103**

#### **A. CLAIMS 180-184, 186-190, 192-208, AND 210-215**

The Examiner has rejected claims 180-184, 186-190, 192-208, and 210-215 under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. Patent No. 6,527,178 to Gordon et al. (“Gordon”) in view of U.S. Patent No. 6,925,451 to Bailey et al. (“Bailey”), or alternatively over Gordon in view of material that the Examiner alleges to constitute admitted prior art (“APA”). This rejection is improper and must be withdrawn for at least the reason that Gordon, either alone or in combination with the alleged APA, fails to disclose, teach, or suggest each and every feature of the claimed invention.

More particularly, Gordon and Bailey, either alone or in combination with the alleged APA, fail to disclose, teach, or suggest at least the combined features that include "reading, at the United States Postal Service, a postage indicium located on a mail piece handled by the United States Postal Service, wherein the postage indicium contains a certificate serial number and a tracking identifier . . . providing a mail piece tracking capability within the United States Postal Service" and "receiving, at the United States Postal Service, data from [a] vendor-controlled postage-issuing computer system indicating whether the tracking identifier contained in the postage indicium matches any records in a transaction database that stores tracking identifiers contained in postage indicia located on mail pieces previously handled by the United States Postal Service, wherein the United States Postal Service submits the mail piece for normal delivery if the data received from the vendor-controlled postage-issuing computer system indicates that the tracking identifier contained in the postage indicium located on the mail piece does not match any of the records in the transaction database," as recited in independent claim 180, for example.

The Examiner alleges that Gordon discloses the foregoing features recited in independent claim 180, and in particular alleges that Gordon discloses a postal authority reading a postage indicium that contains a serial or transaction number, which the Examiner alleges to be the claimed "tracking identifier." Applicants disagree with the Examiner's assessment for at least the reason that the Examiner has mischaracterized the nature of the "serial or transaction number" described in Gordon. For example, independent claim 180 recites that the "tracking identifier" provides "a mail piece tracking capability within the United States Postal Service" (e.g., a delivery confirmation code for Priority Mail, an Express Mail tracking code for Express Mail, a Signature Confirmation code for Priority Mail, etc.). On the other hand, Gordon generally describes techniques "for authenticating mail pieces utilizing ***cryptographically secured or plain text indicia*** printed on the mailpiece as evidence of postage payment" (Abstract). In other words, the "serial or transaction number" described in Gordon relates, at best, to a certificate serial number issued from an Information Based Postage Indicum (IBIP) Certificate Authority.

However, independent claim 1 recites that the postage indicium “contains a certificate serial number” distinctly from the “tracking identifier,” wherein the latter provides the “mail piece tracking capability within the United States Postal Service.” In contrast, the “serial or transaction number” described in Gordon only relates to the “certificate serial number,” but Gordon does not disclose, teach, or suggest that the postage indicium described therein further includes a “tracking identifier” that can be used to track mail pieces within the United States Postal Service. In particular, Gordon describes “maintaining a master log database of the printed indicia” and identifying counterfeit indicia through a comparison between serial or transaction numbers stored in the master log database with serial or transaction numbers scanned from indicia actually carried on mail pieces. Thus, Gordon generally describes techniques to authenticate mail pieces based on whether a serial or transaction number obtained from a scanned postage indicium carried on a mail piece matches a serial or transaction number stored in the master log database to determine whether the postage indicium has been used multiple times (Abstract). Accordingly, the Examiner has improperly conflated the “certificate serial number” and the “tracking identifier” contained in the claimed “postage indicium,” as independent claim 180 recites that the “tracking identifier” (rather than the “certificate serial number”) provides an index to “a transaction database that stores tracking identifiers contained in postage indicia located on mail pieces previously handled by the United States Postal Service.”

Thus, independent claim 180 recites various features that can validate the postage indicia with the “tracking identifier” contained therein to detect copy fraud in scenarios that could escape detection that only verify the certificate serial number in the postage indicium (e.g., Specification, page 53, line 11 – page 54, line 5). For example, validating the postage indicium with the tracking identifier may detect fraud “if the tracking [identifier] obtained from the postage indicium does not match the expected representations of the tracking [identifier] found elsewhere on the mail piece, indicating that the postage indicium has been duplicated,” and further “if two or more of the tracking [identifiers] found on two or more mail pieces match each other, indicating that the tracking [identifiers] have been duplicated to match the duplicated postage indicium” (e.g., Specification, page 18, lines 3-23). On the other hand,

Gordon indicates that "the indicia transaction or serial number is extracted from the scanned indicia and used . . . to locate the database entry for the scanned indicia transaction or serial number" (col. 8, lines 10-14), whereby Gordon does not disclose, teach, or suggest validating the postage indicium with "a tracking identifier [that provides] a mail piece tracking capability within the United States Postal Service," which can be compared to "records in a transaction database that stores tracking identifiers contained in postage indicia located on mail pieces previously handled by the United States Postal Service."

Bailey fails to cure the foregoing deficiencies of Gordon for at least the reason that the Examiner only alleges that "Bailey clearly discloses a unique tracking ID, wherein the unique tracking ID provid[es] a mail piece tracking capability within the United States Postal Service." However, even assuming *arguendo* that the Examiner has correctly characterized Bailey, which Applicants do not concede, a unique tracking identifier alone does not fairly disclose, teach, or suggest using the unique tracking identifier in a context that relates to validating a postage indicium if a tracking identifier contained in a postage indicium located on a mail piece does not match any records in a transaction database that stores tracking identifiers contained in postage indicia located on mail pieces that the United States Postal Service has previously handled. The Examiner appears to be overlooking the functional relationship that the "tracking identifier" has in the claimed invention, which relates to determining whether or not to have the United States Postal Service submit a mail piece based on the status of previously handled tracking identifiers (e.g., to detect potential copy fraud). As such, for at least these reasons, Bailey fails to cure the foregoing deficiencies of Gordon.

In addition, the alleged APA fails to cure the foregoing deficiencies of Gordon for at least the reason that the Examiner only alleges that "APA clearly discloses that [a] certificate serial number and a tracking identifier with tracking capabilities are old and well known." However, even assuming *arguendo* that the Examiner has correctly characterized the description in Applicants' disclosure as APA, which Applicants do not concede, Applicants' disclosure contains no admissions that using tracking identifiers with tracking capabilities in the claimed context was well known. For example, independent claim 180 recites various features that relate to validating a postage indicium located on a mail piece based on whether a

tracking identifier contained in the postage indicium “matches any records in a transaction database that stores tracking identifiers contained in postage indicia located on mail pieces previously handled by the United States Postal Service.” In other words, even assuming that having a postage indicium contain a certificate serial number and a tracking identifier was old and well known, Applicants’ disclosure contains no admissions that such features were old and well known in a context where the United States Postal Service submits a mail piece for normal delivery if data received from a vendor-controlled postage-issuing computer system indicates that a tracking identifier contained in a postage indicium located on a mail piece does not match any tracking identifiers contained in postage indicia located on mail pieces that the United States Postal Service previously handled. Thus, the alleged APA fails to cure the foregoing deficiencies of Gordon for at least this reason.

Accordingly, for at least the foregoing reasons, Gordon and Bailey, either alone or in combination with the alleged APA, fail to disclose, teach, or suggest each and every feature recited in the claimed invention.

Nonetheless, in response to Applicants’ previous arguments addressing these distinctions, the Examiner alleges that an “intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art,” and further alleges that “[i]f the prior art structure is capable of performing the intended use, then it meets the claim.” Furthermore, although the Examiner has agreed that Gordon does not expressly disclose the foregoing features that relate to differences between the claimed “certificate serial number” and the claimed “tracking identifier,” the Examiner alleges that “these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited.” The Examiner therefore contends that the “information collection and storage steps would be performed the same regardless of the data” and that the differences between the claimed “certificate serial number” and “tracking identifier” do not impact patentability because “such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.”

The Examiner's arguments in the Office Action fail to cure the deficiencies of Gordon, Bailey, and the alleged APA noted above for at least the reason that the Examiner has misconstrued the relevant legal standard that applies to patentable distinctions, and moreover because the Examiner has incorrectly alleged that the claimed "certificate serial number" and "tracking identifier" do not functionally relate to the features recited in the claimed invention. Foremost, the Examiner's allegations stand in direct contradiction to one another, for the Examiner first alleges that the claimed "certificate serial number" and "tracking identifier" only relate to functional features that do not structurally differentiate the prior art and then alleges that the same features do not functionally relate to the features recited therein. The Examiner's arguments are therefore contradictory and one or the other must necessarily fail for at least this reason. However, even setting aside this problem with the Examiner's reasoning and taking the Examiner's arguments at face value, the allegation that structural differences are required to distinguish the prior art has no proper legal basis. In particular, functional features "must be evaluated and considered, just like any other limitation of the claim," for what such features fairly convey to a person having ordinary skill in the art. Thus, because settled law unambiguously provides that functional features can properly recite particular capabilities or purposes that such features serve, the Examiner's allegations regarding the alleged lack of structural distinctions has no merit. *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20 (Fed. Cir. 2004); see also MPEP § 2173.05(g).

Finally, the Examiner's allegations that the differences between the claimed "certificate serial number" and "tracking identifier" relate to "the nonfunctional descriptive material and are not functionally involved in the steps recited" does not comport with the plain language associated with the features recited in the independent claims. For example, independent claim 180 clearly recites that the "tracking identifier" provides "a mail piece tracking capability within the United States Postal Service," a function that the subsequent features use to validate the postage indicium. In particular, independent claim 180 further recites transmitting a request that includes "the tracking identifier contained in the postage indicium located on the mail piece" to a vendor-controlled postage-issuing computer system, which then refers to



the tracking identifier in order to determine “whether the tracking identifier contained in the postage indicium matches any records in a transaction database that stores tracking identifiers contained in postage indicia located on mail pieces previously handled by the United States Postal Service.” Accordingly, the “tracking identifier” can be used to detect copy fraud that may occur if the tracking identifier matches any of the records in the database, with the “mail piece tracking capability” providing a mechanism to identify “tracking identifiers contained in postage indicia located on mail pieces previously handled by the United States Postal Service.” In this manner, the “tracking identifier” indeed has a functional role in the claimed features, whereby “the United States Postal Service submits the mail piece for normal delivery if the data received from the vendor-controlled postage-issuing computer system indicates that the tracking identifier contained in the postage indicium located on the mail piece does not match any of the records in the transaction database.”

Accordingly, for at least the foregoing reasons, the Examiner’s arguments in the Office Action fail to cure the deficiencies of Gordon, Bailey, and the alleged APA noted above because the Examiner has applied an improper legal standard to allege that functional features cannot patentably distinguish the prior art and because the Examiner incorrectly alleges that the claimed “certificate serial number” and “tracking identifier” do not have a functional relationship to the features recited in the claimed invention. For at least this reason, Gordon and Bailey, either alone or in combination with the alleged APA, fails to disclose, teach, or suggest at least the foregoing features recited in independent claim 180. The rejection is therefore improper and must be withdrawn.

Independent claim 198 includes features similar to those set forth in independent claim 180. Claims 181-184, 186-190, 192-197, 199-208, and 210-215 depend from and add features to one of independent claims 180 and 198. Thus, the rejection of these claims is likewise improper and must be withdrawn for at least the same reasons

**B. CLAIMS 185, 191, 203, AND 209**

The Examiner has rejected claims 185, 191, 203, and 209 under 35 U.S.C. § 103 as allegedly being unpatentable over Gordon in view of Bailey, and further in view of U.S. Patent

Application Pub. No. 2002/0152174 to Woods et al. ("Woods"), or alternatively over Gordon in view of the alleged APA and "Information-Based Indicia Program" to the United States Postal Service ("USPS"). This rejection is improper and must be withdrawn for at least the reason that the references relied upon, either alone or in combination with the alleged APA, fail to disclose, teach, or suggest each and every feature of the claimed invention.

More particularly, for at least the reasons discussed above, Gordon and Bailey, either alone or in combination fail to disclose, teach, or suggest at least the combined features that include "reading, at the United States Postal Service, a postage indicium located on a mail piece handled by the United States Postal Service, wherein the postage indicium contains a certificate serial number and a tracking identifier . . . providing a mail piece tracking capability within the United States Postal Service" and "receiving, at the United States Postal Service, data from [a] vendor-controlled postage-issuing computer system indicating whether the tracking identifier contained in the postage indicium matches any records in a transaction database that stores tracking identifiers contained in postage indicia located on mail pieces previously handled by the United States Postal Service, wherein the United States Postal Service submits the mail piece for normal delivery if the data received from the vendor-controlled postage-issuing computer system indicates that the tracking identifier contained in the postage indicium located on the mail piece does not match any of the records in the transaction database," as recited in independent claim 180, for example.

Woods fails to cure the foregoing deficiencies of Gordon, Bailey, and the alleged APA for at least the reason that the Examiner has only relied upon Woods as allegedly disclosing techniques that relate to generating and sending tracking identifiers to a postage vendor to enable tracking for mail pieces delivered through the United States Postal Service. However, even assuming *arguendo* that the Examiner has correctly characterized Woods, which Applicants do not concede, issuing tracking identifiers to vendor-controlled postage-issuing computer systems does not disclose, teach, or suggest incorporating the tracking identifiers within postage indicia to validate whether the tracking identifiers have been duplicated, used multiple times, or used in other copy fraud scenarios. For at least this reason, Woods fails to cure the foregoing deficiencies of Gordon, Bailey, and the alleged APA.

In addition, USPS further fails to cure the foregoing deficiencies of Gordon, Bailey, and the alleged APA for at least the reason that the Examiner has similarly only relied upon USPS as allegedly disclosing techniques that relate to generating and sending tracking identifiers to a postage vendor to enable tracking for mail pieces delivered through the United States Postal Service in a manner that complies with IBIP requirements. However, even assuming *arguendo* that the Examiner has correctly characterized USPS, which Applicants do not concede, issuing tracking identifiers to vendor-controlled postage-issuing computer systems does not disclose, teach, or suggest incorporating the tracking identifiers within postage indicia to validate whether the tracking identifiers have been duplicated, used multiple times, or used in other copy fraud scenarios. For at least this reason, USPS further fails to cure the foregoing deficiencies of Gordon, Bailey, and the alleged APA.

Accordingly, for at least the foregoing reasons, the references relied upon, either alone or in combination, fail to disclose, teach, or suggest each and every feature of amended independent claim 180. Independent claim 198 has been amended to include features similar to those set forth in amended independent claim 180. Claims 185, 191, 203, and 209 depend from and add features to one of amended independent claims 180 and 198. Thus, the rejections of these claims are improper and must be withdrawn for at least the foregoing reasons.

## CONCLUSION

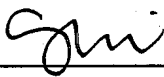
Having addressed each of the foregoing objections and rejections raised by the Examiner, Applicants respectfully submit that a full and complete response has been made to the outstanding Office Action. As such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: September 14, 2010

Respectfully submitted,

By:

  
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